UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,213	07/11/2003	Philip Lee Childs	RPS920030060US1	4227

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EXAMINER
MOAZZAMI, NASSER G

ART UNIT	PAPER NUMBER
2187	

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 April 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This is in response to applicant's amendment dated 04/24/2006 with the following

results.

2.   Claims 8-12 has been canceled. Therefore, claims 1-7 remain pending in this

application.

Response to Arguments

3.   Applicant's arguments filed on 04/24/2006 have been fully considered but they

are not persuasive.

        Applicant states that AAPA and James, taken singly or in combination do not

teach or suggest "a program appliance comprising a program attachable in data

communication with the computer; and a data storage appliance attachable in data

communication with the computer". With respect to this limitation, examiner rejection

based on AAPA is as follow, Fig. 2 of applicant's drawings in combination with the page

6, lines 14-20 states that the prior art had the same structures, meaning that there is a

program appliance having a program therein and attachable to a computer; a data

storage appliance attachable with the computer and the program is configured to copy

files from the hard drive to the storage appliance. Therefore, the only difference

between the prior art and applicant's invention would be the program not being installed

to the hard drive of the computer. Because of this conclusion, in the office

communication with the applicant on 02/01/2006, examiner concluded that AAPA

discloses all the limitations being claimed, however, AAPA fails to discloses without

installing the program from the program appliance into computer's hard drive. In order to

overcome the deficiency of the prior art, James discloses a memory device attachable

to the computer and containing application software (program) which is configured to

run from the memory device upon connection to the host computer rather than being

copied onto computer's hard drive or other permanent memory storage means.

Therefore, it would have been obvious to one having ordinary skill in the art having the

teaching of AAPA and James to use the teaching of James into AAPA's backup system

in order not to copy potentially confidential or personal information into the computer's

permanent memory storage means, leaving it vulnerable to potential access by a

subsequent use of the computer system, Thereby improving the security.

   With respect to program appliance and the data storage appliance being

the same appliance, examiner would like to point out that a recitation directed to the

manner in which a claim is intended to be used does not distinguish the claim from the

prior art if prior art has the capability to do so (See MPEP 2114 and Ex Parte Masham,

2 USPQ2d 1647 (1987). Therefore, since both appliances are portable and attachable

to the computer, both can be of the same type appliances.

   With respect to executing automatically upon being attached to the computer,

firstly examiner would like to state that examiner has pointed out particular references

contained in the prior arts of record in the body of action for the convenience of the

applicant. Although the specified citations are representative of the teachings in the art

and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the future response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner. Secondly as it is evidenced by paragraphs 0014 and 0016, James states that the memory device is advantageously configured as a memory device that may be "hot-plugged" to a host computer by way of a USB port or other I/O port, preferably a fast I/O port, or by a wireless (e.g. Bluetooth.RTM., infrared or RF, for example) or any other appropriate releasable connection and which presents itself automatically to the operating system of a host computer as an additional drive, other device or the like and that it is to be emphasised that embodiments of the present invention provide true cross-platform "hot-plugability", in that data processing may take place on a first host computer of a particular type, the memory device may be disconnected from the first host computer at an arbitrary time without loss of data integrity, and later connected to a second host computer, potentially with a different processor and/or operating system than the first, where data processing can continue from where it left off in the first host computer. For example, where the applications software package is a word processing application, the memory device may be disconnected from the host computer while a user is in the middle of creating a document, without the use having actively to save the document, and upon subsequent reconnection to the same or a different host computer, the word processing application

may be relaunched or automatically recommenced and the document will be available,

optionally automatically being displayed on screen, with no loss of integrity. In another

example, the memory device may be plugged into a USB port on a host computer and a

user's customised desktop, complete with all applications, instantly becomes available

without the need for an installation process. Similarly, the memory device may be

removed from the USB port at any time without requiring a shut-down procedure or the

like.

With respect to data storage appliance being configured to copy files from the

data storage appliance to the hard drive, examiner's passages from James states that

the application software is adapted to send and/or receive data would cover the claimed

limitations for claims 4, and 6.

With respect to combining the references, motivation to combine and

motivational statement for claims 3, 4, 5 and 7, examiner recognizes that references

can not be arbitrarily combined and that there must be some reason why one skilled in

the art would be motivated to make the proposed combination of primary and secondary

references. *In re Nomiya, 184* USPQ 607 (CCPA 1975). However, there is no

requirement that a motivation to make the modification be expressly articulated. The

test for combining references is what the combination of disclosure taken as a whole

would suggest to one of ordinary skill in the art. *In re McLaughlin,* 170 USPQ 209

(CCPA 1971). References are evaluated by what they suggest to one versed in the art,

rather than be their specific disclosures. *In re Bozek,* 163 USPQ 545 (CCPA 1969). In

this case, as it is clear from the previous office action both references AAPA and James

were in the same environment and the motivation to combine the references were given

in the previous office communication. Therefore, the rejections of claims deemed to be

proper.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Applicant Admitted Prior Art (AAPA) in view of James (US Patent Application

Publication No. 2003/0212862).

        As per claims 1, and 6, AAPA discloses a backup system for a computer having

a hard drive comprising: a program appliance comprising a program attachable in data

communication with the computer; and a data storage appliance attachable in data

communication with the computer, wherein the program is configured to copy the files

from the hard drive to the data storage appliance **[backup program resident on the**

appliance 207 instruct the computer 203 to copy data from the computer hard

drive to a data storage appliance 205 (page 6, lines 14-20)].

AAPA discloses the invention, but fails to specifically teach that the program is configured to copy files from the hard drive to the data storage appliance without installation of the program on the hard drive.

James teaches a portable memory device for attachment to a personal computer by way a USB or other port **[page 1, paragraph 0004]**. The memory device containing at least one applications software package, the application software package being configured to run from the memory device upon connection to the host computer **[page 2, paragraph 0011]** rather than being copied onto computer's hard drive or other permanent memory storage means **[page 4, paragraph 0032]**.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the current invention to use the memory device as being disclosed by James into AAPA backup system in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved.

As per claim 2, AAPA and James disclose that the program appliance and the data storage appliance are the same appliance **[see AAPA's Fig. 2 and James's memory device]**.

As per claims 3, and 7, James discloses that the program is further configured to execute automatically upon the program appliance being attached to the computer **[the**

application software package being configured to run from the memory device

upon connection to the host computer; hot-plugability (page 2, paragraphs 0011

and 0013-0014)].

As per claim 4, James discloses that the program is further configured to copy

the files from the data storage appliance to the hard drive without installation of the

program on the hard drive **[the applications software package is adapted to send**

and/or receive data].

As per claim 5, James discloses a network in data communication with the

computer; and a server computer in data communication with the network, wherein the

data communication between the data storage appliance and the computer is provided

through the server **[data and application may be transferred by way of modems and**

a telecommunications network (page 1, paragraph 0003)].

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the
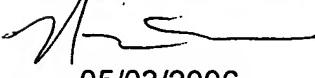
shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nasser G. Moazzami whose telephone number is (571)

272-4195. The examiner can normally be reached on 7:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Donald Sparks can be reached on (571) 272-4201. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

8.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

NASSER MOAZZAMI
PRIMARY EXAMINER

05/03/2006